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APPLICATION NO. 09/161,109	FILING DATE 09/25/98	FIRST NAMED INVENTOR VALLEY	K	ATTORNEY DOCKET NO. SS
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QM22/1023

SERKE, EXAMINER

ART UNIT 3700	PAPER NUMBER
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13 10/23/01

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/161,109

Applicant(s)

VALLEY ET AL.

Examiner

Catherine Serke

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 113-125 is/are pending in the application.
- 4a) Of the above claim(s) 121-125 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 113 is/are rejected.
- 7) ☐ Claim(s) 114-120 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of claims 113-120 in Paper No. 12 is acknowledged. The traversal is on the ground(s) that it would not be a burden to extend the search to the remaining claims in the other species. This is not found persuasive because methods using dual balloons and methods including venting require searches in classes and subclasses not required for the elected species and claims.

The requirement is still deemed proper and is therefore made FINAL.

Double Patenting

Claim 113 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 71 of U.S. Patent No. 5,584,803. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim methods for introducing a catheter into the ascending aorta, positioning an inflatable member on the distal end of the catheter between the coronary ostia and brachiocephalic artery, and expanding and occluding the ascending aorta with the inflatable member.

Claim 113 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 22, 29-30 and 34 of U.S. Patent No. 5,571,215. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim methods for introducing a catheter into the ascending aorta, positioning an inflatable member on the distal end of the catheter between the coronary ostia and

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brachiocephalic artery, and expanding and occluding the ascending aorta with the inflatable member.

Claim 113 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 23 and 28 of U.S. Patent No. 5,458,574. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim methods for introducing a catheter into the ascending aorta, positioning an inflatable member on the distal end of the catheter between the coronary ostia and brachiocephalic artery, and expanding and occluding the ascending aorta with the inflatable member.

Allowable Subject Matter

Claims 114-120 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Serke whose telephone number is 703-308-4846. The examiner can normally be reached on Monday - Friday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharon Kennedy can be reached on 703-305-0154. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3590 for regular communications and 703-306-4520 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2192.



Catherine Serke
October 19, 2001



ANH TUAN T. NGUYEN
PRIMARY EXAMINER
10/22/01